

**REMARKS**

Reconsideration of the present application, as amended, is respectfully requested.

Applicants and the undersigned wish to thank the Examiner for the courtesies extended during the personal interview conducted on June 28, 2005 with applicant Dr. Carl Gilbert.

Since the present amendment raises no new issues for consideration and, in any event, places the present application in better condition for consideration on appeal, it is respectfully requested that this amendment be entered under 37 CFR 1.116 in response to the last Office Action dated April 14, 2005, which made final rejections as to the pending claims.

**A. STATUS OF THE CLAIMS**

As a result of the present amendment claims 1-12, 14, 16, 22, 24, 25 and 31 are presented in the case for continued prosecution. Claims 13, 15, 17-21, 23 and 26-30 were previously withdrawn by the Examiner. It is noted that the present office action does not contain any indication that claims 2-4, 7-8, 10-12, 16, 22 and 25 contain allowable subject matter. This statement was made in the previous office action. Applicants request clarification concerning these claims since there has been no specific rejections made thereof on the basis of prior art or on formal grounds.

**B. THE REJECTIONS UNDER 35 U.S.C. §112, Second Paragraph**

The Examiner has rejected the pending claims as being indefinite. Applicants respectfully traverse the Examiner's statement that the previous response failed to address the rejections made in the previous office action. Nonetheless, in an effort to advance the prosecution of the present application, Applicants have made further amendments to the claims in an effort to overcome the rejections made in the present office action. Specifically, as was offered during the interview, claim 1 has been amended as required by the Examiner with regard to the preamble. The definition of L has been further defined so that its function in the chemical formula is further described. Further discussion concerning the terms "linker" and "electron withdrawing group" is provided below. The suggested changes to claims 5, 6, 9, 24 and 31 have been made. The Examiner's interview summary record is believed to support this position.

Applicants wish to further review their position concerning the definition used in the claims for the terms "linker" and "electron donating or withdrawing groups". During the interview, inventor Carl Gilbert reviewed each of the terms from the prospective of one of ordinary skill in the art. As part of the interview, Applicants offered to provide the Examiner with evidence relating to the acceptance of the term "linker" in the art and the Examiner indicated

that such evidence would be relevant to the issue of indefiniteness. Applicants have therefore attached hereto as Exhibit 1, third party catalog advertisement from Pierce Chemical which gives a review of cross linking reagents (a term used interchangeably with linkers). See pages 307 et seq. Specifically see the passage beginning at the fourth paragraph on the left side of the page 307 which states why such linkers are useful in the art and how various conjugates are made therewith.

In addition, the USPTO has repeatedly accepted the term linker as appropriate in claim language. Even if the Examiner disregards the use of the term in the commonly assigned patent number 6,774,116 (mentioned in the previous response), the USPTO has allowed several thousand claims with the term therein. See for example, US Patent No. 6,914,121 which states in claim 2 thereof: "The method according to claim 1, wherein said PEG moiety is covalently bound to said serine residue of antide via a bifunctional *linker* molecule." Claim 3 states: The method according to claim 2, wherein said bifunctional *linker* molecule is a heterobifunctional *linker* molecule. See also U.S. patent Nos. 6,913,748, 6,908,942, and 6,906,076 as well. Numerous other examples can be given but the point that should be acknowledged by the Examiner is that the law requires the rejection to be withdrawn when the claims read in the light of the specification[s], reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more." (emphasis added).

Turning now to the Examiner's rejection of the use of the terms "electron donating or withdrawing groups, Applicants repeat that which was discussed during the interview. The undersigned provided the Examiner with evidence from the USPTO internet database which showed that such terms are commonly found in the claims of hundreds of patents without further definition in the claims. See also the USPTO print outs identified as Exhibit 2. As the Examiner will appreciate, the terms are well known to those of ordinary skill and Dr. Gilbert provided the Examiner details concerning the use of terms by those of ordinary skill related to the pertinent art herein. It is respectfully submitted that Applicants have completely addressed each of the rejections made by the Examiner. It is urged that the claims are now in proper form and that all rejections under 35 USC §112 can be removed.

#### C. PROVISIONAL REQUEST FOR EXTENSION OF TIME

This response is being filed within the shortened statutory period for response. No further fees are believed to be required. If, on the other hand, it is determined that any further

fees are due or any overpayment has been made, the Commissioner is hereby authorized to debit or credit such sum to deposit account number 02-2275.

Pursuant to 37 C.F.R. 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated therewith is to be charged to Deposit Account No. 02-2275.

**D. REJOINER REQUESTED**

Applicants request that the Examiner rejoin those claims withdrawn previously from consideration in this application. It is believed that the claims for which this rejoinder is requested meet all of the criteria for patentability and that the withdrawn process claims are of a scope commensurate with the allowed product claims.

**E. CONCLUSION**

In view of the actions taken and arguments presented, it is respectfully submitted that the present application is now in condition for allowance.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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